

REMARKS / DISCUSSION OF ISSUES

Claims 1-11 and 13-17 are pending in the application. Claims 14-17 are newly added.

The Office action rejects claim 2 under 35 U.S.C. 112, first paragraph. The applicants respectfully traverse this rejection.

The Office action asserts that the applicants specification fails to teach that the lamp base fractures under a thermal stress of an incandescent mode of the lamp. The applicants respectfully disagree with this assertion. The applicants specifically teach:

"Soft glass has the advantageous property that it has a low softening point and is comparatively sensitive to thermal shocks. When the incandescent mode occurs, the base made of soft glass will deform and crack before excessive temperatures are reached." (Applicants page ???, lines ???).

Because the applicants clearly teach the elements of claim 2, the applicants respectfully maintain that the rejection of claim 2 under 35 U.S.C. 112, first paragraph, is unfounded, and should be withdrawn.

The Office action rejects claims 1-2 and 5-7 under 35 U.S.C. 102(b) over Reger et al. (USP 2,175,361, hereinafter Reger). The applicants respectfully traverse this rejection.

MPEP 2131 states:

"A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)... "The **identical invention** must be shown in as **complete detail** as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Reger does not teach a high-pressure discharge lamp that includes at least one of a lamp base, first contact member and second contact member that is configured to fail upon an occurrence of an incandescent mode of the lamp, as claimed in claim 1, upon which claims 2-11 and 13-17 depend.

The Office action asserts that "the prior art discloses the limitations of the instant claim and therefore the lamp base, first contact member, and second contact member will function as an end-of-life device". The applicants respectfully disagree with this assertion. The mere existence of a lamp base and contact members does not establish any one of these elements as the element that causes the end of the device's life.

However, in the interest of advancing prosecution in this case, the applicants have amended claim 1 to eliminate the reference to the fact that the claimed features provide the function of serving as an end-of-life device. Amended claim 1 now describes the distinctive characteristic/feature, failing upon occurrence of an incandescent mode of the lamp, that the claimed base and/or contact members possess. Reger does not teach a lamp with base and/or contact members that possess this feature, and thus does not disclose an "identical invention" of the applicants' claimed invention.

Accordingly, the applicants respectfully maintain that the rejection of claims 1-2 and 5-7 under 35 U.S.C. 102(b) over Reger is unfounded, and should be withdrawn.

The Office action rejects claim 1 under 35 U.S.C. 103(a) over Reger and Notelteirs et al. (DE 20006208, hereinafter Notelteirs). The applicants respectfully traverse this rejection.

Notelteirs teaches an incandescent lamp, not a high-pressure discharge lamp. The preferred features of an incandescent lamp have no direct bearing on preferable features of a high-pressure discharge lamp, because the principles of operation of both are fundamentally different.

In *KSR Int'l. Co. v. Teleflex, Inc.*, the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed:

"Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**." KSR, 82 USPQ2d 1385 at 1396 (emphasis added).

The Office action asserts that one of skill in the art would have been motivated to combine the teachings of Notelteirs and Reger "in order to prevent the striking of an arc inside of the lamp". This assertion is contrary to the principles of operation of the lamps. Reger's lamp is an arc-discharge lamp; it relies upon the creation of an arc to function (see [0004], [0012], [0046], [0108], and [0112] of Reger). The Office action's assertion that one of skill in the art would be motivated to prevent striking an arc within an arc-discharge lamp has no basis in fact.

Accordingly, because the Office action's assertions regarding the combination of Notelteirs and Reger are unfounded, the applicants respectfully maintain that the rejection of claim 1 under 35 U.S.C. 103(a) over Reger and Notelteirs is unfounded, and should be withdrawn.

The Office action rejects:

claims 2-4, 8, 10-11, and 13 under 35 U.S.C. 103(a) over Reger and Bruggermann et al. (USP 6,204,598, hereinafter Bruggermann); and
claim 9 under 35 U.S.C. 103(a) over Reger and Honda (USPA 2003/0076041). The applicants respectfully traverse these rejections.

Each of the rejected claims are dependent upon claim 1, and in these rejections, the Office action apparently relies upon Reger for teaching the elements of claim 1. As noted above, Reger fails to teach the elements of claim 1. Accordingly, the applicants respectfully maintain that the rejections of claims 2-4, 8-11, and 13 under 35 U.S.C. 103(a) that rely on Reger for teaching the elements of claim 1 are unfounded, and should be withdrawn.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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